

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77871860
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant respectfully suggests that the Examining Attorney erred in the Section 2(d) final refusal of Applicant's mark SIMPLY POTATOES STEAMABLES based on the prior registration of the descriptive mark STEAM'ABLES on the Supplemental Register (Reg. No. 3,529,429). Given the highly descriptive nature of the cited STEAM'ABLES mark and that Applicant's mark includes Applicant's distinctive house mark, SIMPLY POTATOES, and based on the other relevant <i>du Pont</i> factors, Applicant respectfully suggests that there is no likelihood of confusion between Applicant's mark and the cited mark.</p> <p>The cited mark, as evidenced by the fact that it is registered on the Supplemental Register, is merely descriptive. While marks on the Supplemental Register are afforded some protection from marks that are confusingly similar, the Trademark Trial and Appeal Board has made clear that a merely descriptive mark registered on the Supplemental Register is not entitled to the same level of protection as a distinctive mark registered on the Principal Register.</p> <p>The cited registration is a Supplemental Register registration. It is settled that a mark registered on the Supplemental Register is entitled to a quite narrow scope of protection and that it will preclude registration of a later-filed mark <u>only when the two marks are substantially similar</u>.</p>	

In re FA Marketing and Sales, Inc., Serial No. 78315860, Slip Op. at 6 (TTAB, Sept. 13, 2005) (non-precedential) (emphasis added). The two marks at issue here are not “substantially similar.”

While the general rule is that the “likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding . . . a house mark,” exceptions to the general rule arise if the matter common to the marks is merely descriptive or diluted and is not likely to be perceived by purchasers as a distinguishing element. TMEP § 1207.01(b)(iii); *see, e.g., In re PRL USA Holdings, Inc.*, Serial No. 77634450 (March 21, 2011) [not precedential] (RALPH LAUREN STIRRUP COLLECTION allowed to register despite registration of STIRRUP for similar goods). The additional element of the house mark, “SIMPLY POTATOES,” as the initial portion of Applicant’s mark will readily be perceived by consumers as differentiating the two marks, particularly because of the weak, descriptive nature of “STEAMABLES.” Applicant submits herewith the Oxford dictionary definition for the word “steam” that was inadvertently omitted from its prior office action response.

Here, in analyzing whether the marks at issue are “substantially similar,” improper weight has been given to the shared term “steamable.” Where the prior registration consists solely of the shared term and the shared term is inherently distinctive, this emphasis may be appropriate. A different analysis is called for where, as here, the shared term is a highly descriptive word in common use by many others in the same market. In these circumstances, just as in *Knight Textile Corp., In re PRL USA Holdings, Inc.*, and the many other cases decided by the Trademark Trial and Appeal Board and cited by Applicant in its previous responses to office actions, the additional elements of the applied for mark must be considered.

Because the cited mark has a limited scope of protection and the Applicant’s mark includes the additional strong element at the outset of Applicant’s mark, SIMPLY POTATOES STEAMABLES is sufficiently distinct from STEAM’ABLES to distinguish the marks and avoid any likelihood of confusion.

In the final office action the Examining Attorney also asserts that the goods of the two companies

are related because they are all food products. The mere fact that both companies' products are food products does not inexorably lead to a conclusion of likelihood of confusion between the two marks. See *Vitarroz Corporation v. Borden, Inc.*, 644 F.2d 960 (2d Cir. 1981)(the identical word mark, BRAVOS, is used on different snack foods).

With respect to food products, the fact that the two products being compared both are offered in the same channel of trade, food stores, is a particularly unpersuasive factor because of the wide variety of products brought together in a modern supermarket. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 USPQ 151, 152-53 (CCPA, 1978).

Finally, consumers have become much more sophisticated in their choice of food products. Food products are increasingly geared toward the upscale or health-conscious customer who is seeking natural and organic products, consumers who are seeking "better for you" products, consumers who are looking for products they can trust because they are confident with the ingredients and the quality. Consumer "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

"Steaming" food products before serving is seen as a healthful alternative to boiling or other methods of preparation. Steaming a food product is a more healthy alternative because fewer nutrients are lost in the cooking process and no additional calories or fat is introduced in the cooking process. See, *Wikipedia article on "Steaming"* submitted herewith. Accordingly, consumers who select products because they are designed for steaming are more likely to pay closer attention to the product packaging and information contained on the product packaging. As a result, the process in making the final selection of the product is not as likely to be an "impulse" or "grab" purchase, but is more likely to involve some level of consideration and examination of the product packaging.

The products are not identical and the marks are readily distinguishable. It is unlikely and improbable that consumers would be confused by Applicant's use of the mark SIMPLY POTATOES

STEAMABLES for its goods. A highly descriptive marks such as STEAM'ABLES, registered solely on the Supplemental Register, is not entitled to the same level of protection as an inherently distinctive mark unless the two marks are substantially similar. Here, the two marks are not substantially similar. Applicant respectfully requests that the refusal under Section 2(d) be withdrawn and that the application be allowed to proceed to publication.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2011/09/13/20110913110501841429-77871860-002_001/evi_2041548930-105737548_._New_Oxford_American_Dictionary_-_steam_-_2005.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT11\IMAGEOUT11\778\718\77871860\xml15\RFR0002.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\778\718\77871860\xml15\RFR0003.JPG
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2011/09/13/20110913110501841429-77871860-002_002/evi_2041548930-105737548_._Wikipedia_Article_-_Steaming_-_06-SEP-2011.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT11\IMAGEOUT11\778\718\77871860\xml15\RFR0004.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\778\718\77871860\xml15\RFR0005.JPG
DESCRIPTION OF EVIDENCE FILE	The New Oxford American Dictionary definition of the word "steam"; Wikipedia article on steaming food.

SIGNATURE SECTION

RESPONSE SIGNATURE	/Eric D. Paulsrud/
SIGNATORY'S NAME	Eric D. Paulsrud
SIGNATORY'S POSITION	Attorney of record, Minnesota bar member
DATE SIGNED	09/13/2011
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	

	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Sep 13 11:05:01 EDT 2011
TEAS STAMP	USPTO/RFR-204.154.89.30-2 0110913110501841429-77871 860-4806e9bddd7672e872f84 c1dec674dfa797-N/A-N/A-20 110913105737548358

PTO Form (Rev 4/2000)

OMB No. 0651-.... (Exp. 08/31/2004)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77871860** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Applicant respectfully suggests that the Examining Attorney erred in the Section 2(d) final refusal of Applicant's mark SIMPLY POTATOES STEAMABLES based on the prior registration of the descriptive mark STEAM'ABLES on the Supplemental Register (Reg. No. 3,529,429). Given the highly descriptive nature of the cited STEAM'ABLES mark and that Applicant's mark includes Applicant's distinctive house mark, SIMPLY POTATOES, and based on the other relevant *du Pont* factors, Applicant respectfully suggests that there is no likelihood of confusion between Applicant's mark and the cited mark.

The cited mark, as evidenced by the fact that it is registered on the Supplemental Register, is merely descriptive. While marks on the Supplemental Register are afforded some protection from marks that are confusingly similar, the Trademark Trial and Appeal Board has made clear that a merely descriptive mark registered on the Supplemental Register is not entitled to the same level of protection as a distinctive mark registered on the Principal Register.

The cited registration is a Supplemental Register registration. It is settled that a mark registered on the Supplemental Register is entitled to a quite narrow scope of protection and that it will preclude registration of a later-filed mark only when the two marks are substantially similar.

In re FA Marketing and Sales, Inc., Serial No. 78315860, Slip Op. at 6 (TTAB, Sept. 13, 2005) (non-precedential) (emphasis added). The two marks at issue here are not “substantially similar.”

While the general rule is that the “likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding . . . a house mark,” exceptions to the general rule arise if the matter common to the marks is merely descriptive or diluted and is not likely to be perceived by purchasers as a distinguishing element. TMEP § 1207.01(b)(iii); *see, e.g., In re PRL USA Holdings, Inc.*, Serial No. 77634450 (March 21, 2011) [not precedential] (RALPH LAUREN STIRRUP COLLECTION allowed to register despite registration of STIRRUP for similar goods). The additional element of the house mark, “SIMPLY POTATOES,” as the initial portion of Applicant’s mark will readily be perceived by consumers as differentiating the two marks, particularly because of the weak, descriptive nature of “STEAMABLES.” Applicant submits herewith the Oxford dictionary definition for the word “steam” that was inadvertently omitted from its prior office action response.

Here, in analyzing whether the marks at issue are “substantially similar,” improper weight has been given to the shared term “steamable.” Where the prior registration consists solely of the shared term and the shared term is inherently distinctive, this emphasis may be appropriate. A different analysis is called for where, as here, the shared term is a highly descriptive word in common use by many others in the same market. In these circumstances, just as in *Knight Textile Corp.*, *In re PRL USA Holdings, Inc.*, and the many other cases decided by the Trademark Trial and Appeal Board and cited by Applicant in its previous responses to office actions, the additional elements of the applied for mark must be considered.

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sufficiently distinct from STEAM'ABLES to distinguish the marks and avoid any likelihood of confusion.

In the final office action the Examining Attorney also asserts that the goods of the two companies are related because they are all food products. The mere fact that both companies' products are food products does not inexorably lead to a conclusion of likelihood of confusion between the two marks. *See Vitarroz Corporation v. Borden, Inc.*, 644 F.2d 960 (2d Cir. 1981)(the identical word mark, BRAVOS, is used on different snack foods).

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Finally, consumers have become much more sophisticated in their choice of food products. Food products are increasingly geared toward the upscale or health-conscious customer who is seeking natural and organic products, consumers who are seeking "better for you" products, consumers who are looking for products they can trust because they are confident with the ingredients and the quality. Consumer "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

"Steaming" food products before serving is seen as a healthful alternative to boiling or other methods of preparation. Steaming a food product is a more healthy alternative because fewer nutrients are lost in the cooking process and no additional calories or fat is introduced in the cooking process. *See, Wikipedia article on "Steaming"* submitted herewith. Accordingly, consumers who select products because they are designed for steaming are more likely to pay closer attention to the product packaging and information contained on the product packaging. As a result, the process in making the final selection of the product is not as likely to be an "impulse" or "grab" purchase, but is more likely to involve some level

of consideration and examination of the product packaging.

The products are not identical and the marks are readily distinguishable. It is unlikely and improbable that consumers would be confused by Applicant's use of the mark SIMPLY POTATOES STEAMABLES for its goods. A highly descriptive marks such as STEAM'ABLES, registered solely on the Supplemental Register, is not entitled to the same level of protection as an inherently distinctive mark unless the two marks are substantially similar. Here, the two marks are not substantially similar. Applicant respectfully requests that the refusal under Section 2(d) be withdrawn and that the application be allowed to proceed to publication.

EVIDENCE

Evidence in the nature of The New Oxford American Dictionary definition of the word "steam"; Wikipedia article on steaming food. has been attached.

Original PDF file:

http://tgate/PDF/RFR/2011/09/13/20110913110501841429-77871860-002_001/evi_2041548930-105737548_._New_Oxford_American_Dictionary_-_steam_-_2005.pdf

Converted PDF file(s) (2 pages)

Evidence-1

Evidence-2

Original PDF file:

http://tgate/PDF/RFR/2011/09/13/20110913110501841429-77871860-002_002/evi_2041548930-105737548_._Wikipedia_Article_-_Steaming_-_06-SEP-2011.pdf

Converted PDF file(s) (2 pages)

Evidence-1

Evidence-2

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Eric D. Paulsrud/ Date: 09/13/2011

Signatory's Name: Eric D. Paulsrud

Signatory's Position: Attorney of record, Minnesota bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the

applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77871860

Internet Transmission Date: Tue Sep 13 11:05:01 EDT 2011

TEAS Stamp: USPTO/RFR-204.154.89.30-2011091311050184

1429-77871860-4806e9bddd7672e872f84c1dec

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